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Assistant Commissioner for Patents
Washington D.C. 20231
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PATENT

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jc997 U.S. PTO
10/067613
02/04/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Hunter-Cevera *et al.*

Application No.: not yet assigned

Filed:

For: SPECIES SPECIFIC
IDENTIFICATION OF SPORE-
PRODUCING MICROBES USING THE
GENE SEQUENCE OF SMALL ACID-
SOLUBLE SPORE COAT PROTEINS
FOR AMPLIFICATION BASED
DIAGNOSTICS

Art Unit: not yet assigned

PETITION UNDER 37 CFR 1.47(a)

RECEIVED

MAR 07 2002

OFFICE OF PETITIONS

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants petition for filing of a patent application when a joint inventor refuses to join in an application under 37 CFR 1.47(a). Applicants submit evidence required under 37 CFR 1.47(a) to establish that two of the joint inventors, Ms. Nancy McKinney and Dr. Jennie Hunter-Cevera, have refused to join in the application. In particular, Applicants submit a copy of the Declarations signed by the signing inventors (see Exhibit A) and a copy of two letters sent by Dr. Hunter-Cevera and Ms. McKinney, respectively (see Exhibit B), stating that they have received the application papers and refuse to sign.

Signing inventors, Dr. Pascal Longchamp, Dr. Stan Goldman, and Dr. Terrance Leighton have executed a Declaration on their own behalf and on behalf of nonsigning inventors, Dr. Hunter Cevera and Ms. McKinney, as provided by 37 CFR 1.47(a). Thus, this petition is being made by Dr. Longchamp, Dr. Goldman, and Dr. Leighton, on behalf of nonsigning inventors Dr. Hunter Cevera and Ms. McKinney.

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Please see attached copy of the Declarations signed by Dr. Longchamp, Dr. Goldman, and Dr. Leighton.

Dr. Hunter Cevera and Ms. McKinney believe Ms. McKinney to be the sole inventor of the invention and therefore, refuse to sign the application papers. Applicants submit that all five named inventors are joint inventors of the claimed invention. In *Monsanto Co. v. Kamp*, 145 USPQ 259, joint inventorship is defined as follows:

A joint invention is the product of collaboration of the inventive endeavors of two or more persons working toward the same end and producing an invention by their aggregate efforts. To constitute a joint invention, it is necessary that each of the inventors work on the same subject matter and make some contribution to the inventive thought and to the final result. Each needs to perform but a part of the task if an invention emerges from all of the steps taken together. It is not necessary that the entire inventive concept should occur to each of the joint inventors, or that the two should physically work on the project together. One may take a step at one time, the other an approach at different times. One may do more of the experimental work while the other makes suggestions from time to time. The fact that each of the inventors plays a different role and that the contribution of one may not be as great as that of another, does not detract from the fact that the invention is joint, if each makes some original contribution, though partial, to the final solution of the problem.

As explained in Dr. Hunter-Cevera's letter dated January 16, 2002, Dr. Hunter-Cevera was responsible for organizing a team of research scientists to work towards the discovery of a spore coat protein specific to *B. anthracis*. The research team consisted of Dr. Hunter-Cevera, Dr. Longchamp, Dr. Leighton, Dr. Goldman and Ms. McKinney. Weekly meetings were organized by Dr. Hunter-Cevera at which time the scientists discussed the progress of their particular assignments. Each scientist was working as part

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of a cooperative team to identify a signature sequence for detection of *B. anthracis*. Ms. McKinney designed the primers to *saspB* that led to the discovery of the signature sequence.

As a result of the discovery, a provisional patent application was filed in the U.S. Patent Office. The provisional application claimed the *sasp-B* protein unique to *B. anthracis*, antibodies to the protein, general methods of detecting *B. anthracis* in a sample by primer amplification and the specific primers designed by Ms. McKinney (see Exhibit C for a copy of the claims filed in the provisional application). On June 8, 2000, a non-provisional application, U.S. Application No. 09/590,759 ('759), was filed, claiming priority to the provisional application, and naming Ms. McKinney as the sole inventor. The '759 application specifically claims the PCR primers designed by Ms. McKinney and methods of using those specific primers to detect *B. anthracis* (see Exhibit D for a copy of the claims filed in the '759 application). The '759 application does not claim the *B. anthracis sasp-B* protein, antibodies to the *B. anthracis* protein or general methods of detecting *B. anthracis* by primer amplification.

With the application filed today, Applicants claim the *B. anthracis sasp-B* protein, antibodies to the *B. anthracis* protein and general methods of detecting *B. anthracis* by primer amplification (see Exhibit E for a copy of the claims filed on February 4, 2002). Applicants do not claim the specific primers designed by Ms. McKinney and claimed in the '759 application. Applicants acknowledge that the specific primers designed by Ms. McKinney are not part of the joint discovery. However, Applicants submit that the joint discovery embraces the claims directed to the *B. anthracis sasp-B* protein, antibodies to the *B. anthracis* protein and general methods of detecting *B. anthracis* by primer amplification. The signature sequence of *B. anthracis* was discovered as a result of the joint collaboration between the research team organized by Dr. Hunter-Cevera. Therefore, all members of the research team are entitled, under the United States Patent Laws, to be named inventors.

The concept of joint inventorship has been explained to all five members of the research team, including Ms. McKinney and Dr. Hunter-Cevera. All five inventors

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have indicated that they worked together as a cooperative team to identify a signature sequence for the detection of *B. anthracis*, yet, Dr. Hunter-Cevera and Ms. McKinney refuse to sign the papers, erroneously believing Ms. McKinney to be the sole inventor of the whole discovery.

In view of Dr. Hunter-Cevera's and Ms. McKinney's refusal to sign the application papers, it is requested that the application be filed on behalf of Dr. Longchamp, Dr. Goldman, and Dr. Leighton pursuant to 37 CFR 1.47(a).

Please charge \$130.00 for filing this petition to Deposit Account 20-1430. The commissioner is hereby authorized to charge any additional fees associated with this paper or during the pendency of this application, or credit any overpayment, to Deposit Account 20-1430.

Respectfully submitted,



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